

Serial No. 10/032,238  
Docket No. 0075.00

## REMARKS

### I. Introductory Comments

In the Office Action under reply, the Examiner rejected the claims as follows: under 35 U.S.C. §103(a)<sup>1</sup> as allegedly being unpatentable over Nossal in view of Platz *et al.* (U.S. Patent No. 6,582,728) (claims 1-40); under 35 U.S.C. §103(a) as allegedly being unpatentable over Mosley *et al.* (U.S. Patent No. 5,599,905) in view of Platz *et al.* (U.S. Patent No. 6,582,728) (claims 1-40); and under 35 U.S.C. §103(a) as allegedly being unpatentable over Lange in view of Platz *et al.* (U.S. Patent No. 6,582,728) (claims 1-40). The rejections are traversed for reasons provided below.

### II. Amendments to the Claims

Claims 1-40 were previously pending in the application and claims 41-43 were withdrawn by the Examiner. Claims 1, 24 and 26-29 have been amended. Claims 23, 33 and 41-43 have been canceled without prejudice. Consequently, claims 1-22, 24-32 and 34-40 remain pending.

Claim 1 has been amended to include the elements recited in claims 24 and 33. In addition, claim 1 has been amended to recite "soluble" interleukin-R receptor, support for which can be found on page 2, lines 1-5, and the paragraph bridging pages 7 and 8.

Claims 24 and 26-29 have been amended to correct dependencies or correct matters relating to form based on the cancellation and/or amendment of other claims.

As support for the claimed subject matter is found in the application as filed, no new matter is introduced by the entry of the above-identified changes to the claims. The changes to the claims are made for clarification purposes only should not be interpreted as acquiescence in any claim rejection.

<sup>1</sup> The Office Action states actually recites that "Claims 1-40 are rejected a under 35 U.S.C. 102(b) as being anticipated by Nossal (1948) in view of Platz *et al.* (U.S. Patent No. 6,582,728)." The context of the Office Action, however, makes clear the rejection is intended to be based on obviousness under 35. U.S.C. 103(a). If this interpretation is incorrect, the Examiner is requested to clarify the matter in the next communication.

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### III. The Restriction Requirement

Claims 41-43 were withdrawn from further consideration by the Examiner in view of a restriction requirement made final in the March 31, 2004, Office Action.

In an effort to expedite the prosecution of the examined claims, Applicants have canceled claims 41-43 without prejudice. Applicants reserve the right, however, to prosecute the subject matter of claims 41-43 in one or more applications claiming priority to the present application.

### IV. The Interview of December 2, 2004

At the Examiner's request, an interview with the undersigned was conducted on December 2, 2004. During the interview, the scope of the claims was discussed and clarified.

### V. The First Rejection Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-40 under 35 U.S.C. §103(a) as being allegedly unpatentable over Nossal (1948) *Nature* 162:36-37 ("Nossal") in view of Platz *et al.* (U.S. Patent No. 6,582,728). This rejection is respectfully traversed in view of the following remarks.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As amended, the pending claims encompass subject matter that is neither disclosed nor suggested by the cited art. Because the Examiner is not able to show (a) the required suggestion or motivation, (b) a reasonable expectation of success, and/or (c) the references when combined teach or suggest all the claim limitations, the Examiner has failed to set forth a *prima facie* case of obviousness. Thus, for at least this reason, this obviousness rejection of the claims under 35 U.S.C. §103(a) is unsustainable. Reconsideration and withdrawal of the rejection is respectfully requested.

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#### VI. The Second Rejection Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-40 under 35 U.S.C. §103(a) as being allegedly unpatentable over Mosley *et al.* (U.S. Patent No. 5,599,905) in view of Platz *et al.* (U.S. Patent No. 6,582,728).

This rejection is respectfully traversed in view of the following remarks.

The three criteria for establishing a *prima facie* case of obviousness have been set forth in Section V, above.

As amended, the pending claims encompass subject matter that is neither disclosed nor suggested by the cited art. Because the Examiner is not able to show (a) the required suggestion or motivation, (b) a reasonable expectation of success, and/or (c) the references when combined teach or suggest all the claim limitations, the Examiner has failed to set forth a *prima facie* case of obviousness. Thus, for at least this reason, this obviousness rejection of the claims under 35 U.S.C. §103(a) is unsustainable. Reconsideration and withdrawal of the rejection is respectfully requested.

#### VII. The Second Rejection Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-40 under 35 U.S.C. §103(a) as being allegedly unpatentable over Mosley *et al.* (U.S. Patent No. 5,599,905) in view of Platz *et al.* (U.S. Patent No. 6,582,728).

This rejection is respectfully traversed in view of the following remarks.

The three criteria for establishing a *prima facie* case of obviousness have been set forth in Section VI, above.

As amended, the pending claims encompass subject matter that is neither disclosed nor suggested by the cited art. Because the Examiner is not able to show (a) the required suggestion or motivation, (b) a reasonable expectation of success, and/or (c) the references when combined teach or suggest all the claim limitations, the Examiner has failed to set forth a *prima facie* case of obviousness. Thus, for at least this reason, this obviousness rejection of the claims under 35 U.S.C. §103(a) is unsustainable. Reconsideration and withdrawal of the rejection is respectfully requested.

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### VIII. The Third Rejection Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-40 under 35 U.S.C. §103(a) as being allegedly unpatentable over Lange (1999) *Cardiovascular, Pulmonary and Renal Investigational Drugs* 1(4): 526-531 ("Lange") in view of Platz *et al.* (U.S. Patent No. 6,582,728).

This rejection is respectfully traversed in view of the following remarks.

The three criteria for establishing a *prima facie* case of obviousness have been set forth in Section VI, above.

As amended, the pending claims encompass subject matter that is neither disclosed nor suggested by the cited art. Because the Examiner is not able to show (a) the required suggestion or motivation, (b) a reasonable expectation of success, and/or (c) the references when combined teach or suggest all the claim limitations, the Examiner has failed to set forth a *prima facie* case of obviousness. Thus, for at least this reason, this obviousness rejection of the claims under 35 U.S.C. §103(a) is unsustainable. Reconsideration and withdrawal of the rejection is respectfully requested.

### IX. Conclusion

In view of the foregoing, Applicants submit that the pending claims satisfy the requirements of patentability and are therefore in condition for allowance. Reconsideration and withdrawal of all objections and rejections is respectfully requested and a prompt mailing of a Notice of Allowance is earnestly solicited.

If a telephone conference would expedite the prosecution of the subject application, the Examiner is requested to call the undersigned at (650) 620-5506.

Respectfully submitted,  
Nektar Therapeutics

Date: December 13, 2004

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